

REMARKS

Claims 1-20 are pending in the application. Claims 1-20 have been rejected. Claims 1, 7, and 15 have been amended. No new matter has been added.

The Advisory Action dated February 2, 2006, acknowledges that the limitation “determining the media formats the agents *can access*” has changed to “determining the media formats the agents *are authorized to access*” and concludes that the amendments require further consideration. A Request for Continued Examination under 37 C.F.R. § 1.114 is submitted accompanying this paper.

Rejection of Claims under 35 U.S.C. §102

Claims 1-4, 7-10 and 13-18 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Dilip, et al., U.S. Patent No. 6,704,409. Applicants respectfully traverse this rejection.

With regard to the limitation “determining the media formats the agents *can access*,” Applicants would like to address the argument presented in the Advisory Action, a portion of which is repeated below:

Dilip teaches that the procedure identifies an agent or group of agents that should handle the transaction (col. 11, lines 20-21). Therefore, it is inherent that Dilip teaches determining the media formats that agents *can access*. For example, an agent handling only telephone call transaction[s] may use only a telephone system without the need for a computer. Similarly, an agent handling only e-mail messages may require a computer system, but not a telephone (col. 5, lines 12-21).

Applicants respectfully disagree that identifying an agent to handle a transaction inherently teaches determining the media formats that the agent is authorized to access. Having the authorization to handle transactions of a given media format is very different from having access to the equipment to handle transactions of that given media format. Authorization for a given media format can be used to distinguish between agents that have identical equipment.

Furthermore, having authorization for particular media formats enables agents to be mobile and not permanently associated with a given set of equipment. Instead, an agent can work using any equipment that can receive the authorized media formats, and authorization is a characteristic of the agent as a person, not of the equipment the agent is using. In contrast, the system proposed by Dilip routes transactions based upon the type of equipment with which the agent is associated, rather than based upon any information about media formats the agent is authorized to handle.

Furthermore, Applicants note that “[i]nherent anticipation requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002). The Examiner bears the burden of showing that missing descriptive material is necessarily present. “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” (emphasis in original) MPEP § 1221 quoting *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). No such basis in fact or technical reasoning has been shown.

Applicants respectfully submit that identifying an agent or group of agents that should handle a transaction does not necessarily require determining the media formats that each agent is authorized to access. For example, Dilip suggests that each agent may be equipped with a telephone and a computer and therefore be capable of responding to multiple types of transactions. (See Dilip, column 5, lines 19-21). The fact every agent is equipped to handle multiple types of transactions does not necessarily require that each agent is authorized to handle transactions in multiple media formats.

Applicants have demonstrated that the transactional processing described by Dilip cannot be interpreted to suggest determining the media formats that an agent is authorized to access (i.e., determining which of a number of media formats the agent is authorized to access). As an example, but only one of many, a situation can arise in the use of the claimed invention in which two or more transactions of the same media format (i.e., two e-mails) are the subject of the claimed determining and assigning, a situation which the claimed invention handles with aplomb. Dilip, in contrast, is completely incapable of making such a distinction. Furthermore, because Dilip does not analyze (and so determine) the media formats that agents are authorized to access, Dilip cannot use the media formats the agents are authorized to access to make a decision in assigning agents to handle requests, as required by the second limitation of claim 1. Management of requests based on such a parameter is simply not taught by Dilip. This infirmity results from the fact that Dilip lacks the concept of authorization.

Because all limitations of the independent claims are not taught by the Dilip reference in combination with the teachings of the prior art, Applicants respectfully submit that independent claims 1, 7, and 15 are allowable, along with respective dependent claims 2-6, 8-14, and 16-20.

*Rejection of Claims under 35 U.S.C. §103*

Claims 5, 6, 11, 12, 19, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dilip, et al., U.S. Patent No. 6,704,409, in view of Miloslavsky, U.S. Patent No. 5,915,011. The Final Office Action states that “it would have been obvious to incorporate the feature of allowing the agent to decline or route the request to another agent in Dilip’s system, thus making the system more efficient by allowing the customer to receive the best service from an agent who has specific skills and knowledge, and is able and ready to provide the needed service.”

In response to the Applicants' argument that Dilip and Miloslavsky are not properly combinable, the Advisory Action points out that the two references are classified by the patent classification system into the same class and subclass. (See Advisory Action, page 2, third paragraph.) The fact that Dilip and Miloslavsky are classified by the patent classification system into the same class and subclass has no relevance to the question of whether the basic requirements of a *prima facie* case of obviousness have been met.

Applicants respectfully submit that such an argument fails to establish a *prima facie* case of obviousness and runs perilously close to a forbidden hindsight analysis of the references. The Office Action makes no showing of a motivation to combine Dilip with Miloslavsky from within the references themselves; therefore, it must be presumed that there is none. It is well-established that the best defense to hindsight is a "rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references." See *Ecolchem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1371 (Fed. Cir. 2000); *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000). A showing of combinability must be "clear and particular" and "broad conclusive statements about the teaching of multiple references, standing alone, are not 'evidence.'" See *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 666 (Fed. Cir. 2000); *Brown & Williamson*, 229 F.3d at 1125.

The reason, suggestion, or motivation to combine may be found explicitly or implicitly: 1) in the prior art references themselves; 2) in the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, "leading inventors to look to references relating to possible solutions to that problem."

*Ruiz*, 234 F.3d at 665.

The Office Action presents nothing more than broad, generalized statements related to the motivation of a person of ordinary skill, which Applicants respectfully submit is insufficient to support a finding of obviousness. The Office Action does not establish that the references which are combined are of special interest or importance in the field. Nor does the Office Action present any evidence of a problem to be solved from within those references themselves.<sup>1</sup> Instead, the Office Action fabricates such a problem to be solved, not from the teachings of the cited references, but from the teaching of Applicants' own disclosure.

Using Applicants' own disclosure as a blueprint for providing the motivation to combine prior art references in an obviousness determination is impermissible. *See W.L. Gore & Assoc. v. Garlock*, 721 F.2d 1540, 1552-53 (Fed. Cir. 1983) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.").

In this case, the requirement that the prior art must suggest the desirability of the claimed invention has been shown to be lacking. Furthermore, the intended function of Dilip's transaction control system would be destroyed by modifying it to allow an agent to decline the request or route the request to another agent. Dilip uses a centralized transaction controller to assign respective priorities to incoming requests. Dilip's transaction processing system also determines whether an agent is available to receive the highest priority request and provides the highest priority request to an available agent. (See Dilip, Abstract.) Dilip's transaction controller may also associate a Quality of Service (QoS) with each received transaction. (Id.)

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<sup>1</sup> There must be a finding that "there was a disadvantage to the prior systems, such that the 'nature of the problem' will have motivated a person of ordinary skill to combine the prior art references." *Id.* at 666.

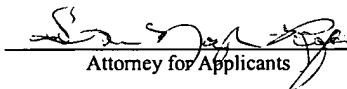
Assigning priorities and meeting QoS requirements are tasks that require knowledge of transaction queues and priorities of other pending requests. Consequently, the system of Dilip is unlikely to be modified to allow an available agent to decline a request or route a request to another agent, as this would conflict with the intended function of Dilip's transaction processing system. For example, the agent will not have knowledge of the transaction queues and priorities of other pending requests. Providing the ability for an agent to override the priority and queuing system could compromise the ability to meet QoS standards, which directly conflicts with the purpose of Dilip's transaction processing system. Applicants reiterate their position that one of ordinary skill in the art would thus have no motivation to modify Dilip's transaction processing system with the rerouting and declining features of Miloslavsky's system. Therefore, each of claims 5, 6, 11, 12, 19, and 20 is allowable for at least this reason.

Further with regard to the rejection of claims 5, 6, 11, 12, 19, and 20, each of claims 5, 6, 11, 12, 19, and 20 depends from one of independent claims 1, 7, and 15. Independent claims 1, 7, and 15 have been shown to be allowable over the Dilip reference standing alone. Accordingly, claims 5-6, 11, 12, 19 and 20 are allowable for at least the foregoing reasons.

CONCLUSION

In view of the amendments and remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5086.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on March 3, 2006.

  
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3/3/06  
Date of Signature

Respectfully submitted,



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